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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,539	01/05/2007	Wilhelm Ardes	4441.75877	9308
24978 7590 04/22/2009 GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606				
EXAMINER GONZALEZ, MADELINE				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,539

Applicant(s)

ARDES, WILHELM

Examiner

MADELINE GONZALEZ

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

In reply to applicant's response dated January 20, 2009

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-17 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumann (U.S. 5,538,626).

With respect to **claim 15**, Baumann discloses a filter 1, as shown in Fig. 1, having:

- a filter socket having a mounting flange 24 that can, in a sealing manner, be connected to a companion flange 7 on the associated apparatus to form a flange connection;
- at least one fluid duct 73 for supplying fluid to be filtered from the apparatus to the fluid filter and one fluid duct 74 for discharging filtered fluid from the filter to the apparatus extending through said flange connection;
- a sealing plate 20 arranged to close off at least one section of at least one of said fluid ducts, such as duct 73, said sealing plate 20 having at least one

- through opening 23 that is sealed against the companion flange 7 and being arranged flush with an apparatus-side fluid duct 73,
- a surface area of said sealing plate 20, as seen on a plane of said flange connection, being smaller than a surface area of said mounting flange 24; and
 - said sealing plate 20 being inserted in said filter socket in a sealing manner and forming a part of said filter socket; and
 - a third fluid duct 25 being a drain duct, as shown in Fig. 1.

With respect to **claim 16**, Baumann discloses wherein said fluid filter includes an oil or fuel filter for an internal combustion engine (see col. 1, lines 6-7).

With respect to **claim 17**, Baumann discloses wherein at least two separate sealing plates are provided, the second sealing plate composed by element 3 and valve 39, one sealing plate being allocated to each of said at least two fluid ducts 73, 74, extending through said flange connection, as shown in Fig. 1.

With respect to **claim 27**, Baumann discloses wherein a peripheral axially acting seal 22 is provided in parallel to an outer contour of said mounting flange 24 and arranged therein, said seal 22 enclosing said through opening, as shown in Fig. 1.

With respect to **claim 28**, Baumann discloses wherein said seal 22 simultaneously seals the fluid duct 73 in the flange connection that is not extending through said through opening in said sealing plate 20, as shown in Fig. 1.

With respect to **claim 29**, Baumann discloses wherein the fluid duct 74 not extending through said through opening in said sealing plate is separately sealed by its own sealing means 22 and said seal encloses the fluid duct in said flange connection not extending through said through opening in said sealing plate, as shown in Fig. 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 19, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann (U.S. 5,538,626) in view of Jainek (U.S. 6,746,604).

With respect to **claims 18 and 33**, Baumann discloses all the subject matter claimed above, with respect to claim 15, and wherein, as a third fluid duct, an unpressurized drain duct 25 arranged to drain the fluid filter upon replacement of a filter element of the filter extends through the flange connection 24, as shown in Fig. 1.

Baumann **lacks** the drain duct extending through the flange connection between the mounting flange and the companion flange.

Jainek teaches a filter, as shown in Fig. 1, having an inlet duct 13, an outlet duct 15 and a drain opening 15, said opening 15 located at an end of housing 10. It would have been obvious to provide the drain duct disclosed by Baumann at the end of the housing as taught by Jainek since the courts have held that shifting the position of a particular element is unpatentable as long as the operation of the device is not modified (see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)). It would be also obvious to provide a corresponding duct in the flange 7, since Baumann already suggest such an arrangement for the inlet and the outlet, as shown in Fig. 1.

With respect to **claims 19 and 34**, Baumann discloses wherein at least three separate sealing plates are provided, one sealing plate being allocated to each of said at least three fluid ducts extending through said flange connection, the third sealing plate being element 26, as shown in Fig. 1. Janiek teaches a sealing plate 24 to seal the drain opening, and it would be obvious to provide such as a sealing plate to the drain duct of Baumann in order to seal the drain opening during normal operation irrespective of tolerances and opens during maintenance or when the filter element is being replaced (see col. 1, lines 35-40).

Claims 20, 21 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann (U.S. 5,538,626) in view of Koivula et al. (U.S. 6,187,191) [hereinafter Koivula] and Steger, Jr. et al. (U.S. 6,554,140) [hereinafter Steger].

With respect to **claim 20**, Baumann **lacks** the specific material of the filter socket and the sealing plate, i.e., plastic, and the sealing plate being one of welded and glued to the filter socket.

With respect to the specific material of the filter socket and the sealing plate, i.e., plastic: Koivula teaches a filter socket formed at an end of casing 7, and a sealing plate 16, both made of a plastic material (see col. 3, lines 7-9, and 26-27). It would have been obvious to make the socket and sealing plate disclosed by Baumann from a plastic material as taught by Koivula, in order to provide resistant and durable parts, since plastic is a well known material used in the manufacture of filtering parts.

With respect to the sealing plate being one of welded and glued to the filter socket: Steger teaches the use of adhesive to secure a plate 22 (sealing plate) to the shell 23 (socket). It would have been obvious to use adhesive as taught by Steger to connect the sealing plate to the socket in order to secure the sealing plate to the socket (see col. 3, lines 49-51).

With respect to **claim 21**, Baumann discloses wherein said sealing plate 20, at its through opening, is provided with a pipe socket 3 having a radially acting sealing ring, wherein said pipe socket projects towards the companion flange and can be inserted in an apparatus-side fluid duct, as shown in Fig. 1.

With respect to **claim 31**, Koivula further teaches the sealing plate is produced as an injection-molded part (see col. 3, lines 26-27). Baumann and Koivula **lacks** the socket produced as an injection molding part and the specific type of plastic, i.e., polyamide.

With respect to the sealing plate produced as an injection-molded part: It would have been obvious to make the filter socket as an injection-molded part, since injection molding is a well known process of producing plastic products. Furthermore claim 31 is considered to be a product-by-process claim since it is drawn to a product, i.e., a fluid filter, but it includes a process step of making the product, i.e., "produced as injection-molded parts". "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" (see MPEP 2113 [R-1], In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (FED. Cir. 1985)).

With respect to the specific type of plastic to make the sealing plate and socket, i.e., polyamide: Baumann teaches the use of polyamide to make the face end disks. It would have been obvious to use polyamide to make the sealing plate and socket in order to provide a material that allow a complete thermal processing after being used (see col. 5, lines 54-59).

Claims 22-26, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann (U.S. 5,538,626) in view of Koivula (U.S. 6,187,191).

With respect to **claim 22**, Baumann **lacks** the specific material of the filter socket and the sealing plate, i.e., plastic, and a sealing ring inserted between the filter socket and the sealing plate. Koivula teaches a filter socket formed at an end of casing 7, and a sealing plate 16, both made of a plastic material (see col. 3, lines 7-9, and 26-27). Koivula further teaches a sealing ring 17 inserted between the filter socket and the sealing plate 16, as shown in Fig. 1. It would have been obvious to make the socket and sealing plate disclosed by Baumann from a plastic material as taught by Koivula, in order to provide resistant and durable parts, since plastic is a well known material used in the manufacture of filtering parts. Furthermore, it would have been obvious to provide a sealing ring between the filter socket 24 and the sealing plate 20 disclosed by Baumann since the courts have held that if it were considered desirable for any reason to obtain access the end of a component having a cover, it would be obvious to make the cover removable for that purpose (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)).

With respect to **claim 23**, Koivula further teaches wherein said sealing ring 17 acts radially, as shown in Fig. 1.

With respect to **claim 24**, Koivula further teaches wherein said radially acting sealing ring 17 is a standard O-ring (see col. 3, lines 26-28).

With respect to **claim 25**, Koivula further teaches wherein said sealing ring 17 acts axially, as shown in Fig. 1.

With respect to **claim 26**, Baumann discloses wherein said sealing plate 20, at its through opening, is provided with an axially acting sealing ring 22 surrounding said through opening and projecting in a direction of the companion flange, as shown in Fig. 1.

With respect to **claim 30**, Baumann discloses wherein said axially acting seal 22 is a sectional seal, as shown in Fig. 1.

With respect to **claim 32**, Baumann discloses wherein said metal is one of aluminum and magnesium and said filter socket and said sealing plate are produced as die casting parts (see col. 5, lines 41-45).

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann (U.S. 5,538,626) in view of Jaineck (U.S. 6,746,604) as applied above with respect to claim 34 and further in view of Koivula (U.S. 6,187,191).

With respect to **claim 35**, Baumann discloses wherein said filter socket and said sealing plate are parts made of metal (see col. 5, lines 41-45) and said sealing plates are inserted into said filter socket and fixed therein. Baumann **lacks** a sealing ring

between the socket and the plate. Koivula teaches a sealing ring 17 inserted between the filter socket and the sealing plate 16, as shown in Fig. 1. It would have been obvious to provide a sealing ring between the socket and the plate in order to leak-proof the connection and since the courts have held that if it were considered desirable for any reason to obtain access the end of a component having a cover, it would be obvious to make the cover removable for that purpose (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)).

Response to Arguments

Applicant's arguments, see page 7, lines 24-27, filed on January 20, 2009, with respect to the rejection(s) of claim(s) 33 under 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Baumann and Jainek, as stated above.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the sealing plate being a separate part from the filter socket) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). All the claim requires with the limitation "said sealing plate being inserted in said filter socket" is that the sealing plate should

have some part inside the filter socket, and Baumann teaches a face wall 20 (sealing plate) having a surface inside the filter socket, as shown in Fig. 1. Furthermore, to make the plate separate from the filter socket would have been obvious since the courts have held that if it were considered desirable for any reason to obtain access the end of a component having a cover, it would be obvious to make the cover removable for that purpose (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)).

In response to applicant's argument that the surface area of the face wall 20 of Baumann is not smaller than a surface area of the mounting flange 24 as required by claim 15: Baumann teaches that the housing 2 is formed by a face wall 20 (sealing plate) and a circumferential wall 24 (mounting flange) (see col. 6, lines 17-19); therefore, the wall 24 is surrounding the wall 20 and the wall 20 is smaller than the wall 24, as claimed by applicant.

In response to applicant's argument that the intake channel 23 of Baumann is not separately sealed against the flange 7: This is not commensurate in scope with the claim. Baumann teaches the sealing plate 20 having a through opening 23 that is sealed against the companion flange 7 and being flush with an apparatus-side fluid duct 73, as shown in Fig. 1 and as claimed in claim 15.

In response to applicant's argument that In Baumann the inlet and outlet extend through the face wall 20, not the wall 24, which the Examiner equates with the flange connection: The circumferential wall 24 of Baumann has been considered the mounting flange. The flange connection is the connection between the mounting flange and the companion flange, as claimed by applicant. Baumann teaches the inlet and outlet ducts

extending through the flange connection, i.e., extending through the connection between the mounting flange 24 and the companion flange 7, as shown in Fig. 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M, T, Th, F- 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Madeline Gonzalez
Patent Examiner
April 20, 2009

/Krishnan S Menon/
Primary Examiner, Art Unit 1797